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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/299,539	04/26/1999	ANTONIO MUNOZ-ESCALONA LAFUENTE	B-3643-61707	3400
7590 04/21/2004			EXAMINER	
LADAS & PARRY 5670 WILSHIRE BOULEVARD SUITE 2100 LOS ANGELES, CA 900365679			PASTERCZYK, JAMES W	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/299,539	<b>Applicant(s)</b> MUNOZ-ESCALONA LAFUENTE ET AL.	
	<b>Examiner</b> J. Pasterczyk	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-18, 20, 21, 23-25 and 27-39 is/are pending in the application.
- 4a) Of the above claim(s) 8, 20, 38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-18, 21, 23-25 and 27-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8, 10-18, 20, 21, 23-25 and 27-39 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/22/02, 2/28/03</u> . | 6) <input type="checkbox"/> Other: _____  |

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1. This Office action is in response to the amendment filed 11/24/03 and refers to the Office action mailed 12/23/02.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7, 10-18, 21, 23-25 and 27-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 10-20 of copending Application No. 09/300302. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to be only very minor modifications of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-7, 10-18, 21, 23-25 and 27-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 08/961956. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to be only very minor modifications of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-7, 10-18, 21, 23-25 and 27-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 21 appear to be almost verbatim duplicates of each other. Some of their dependent claims likely are also. One or the other groups of claims should be cancelled or amended to make a clear distinction between the two groups. Claim 1 recites a catalytic composition, while claim 21 recites a catalytic system. There is no patentable difference between the two. However, the dependent claims of each should at least be consistent with the language used in the independent claim from which they depend; this is not done consistently.

In claim 6 it is not clear that the transition metal recited is that of groups 3, 4, 10, the lanthanides or actinides as recited in claim 1, or from some other metal compound.

In claim 10 insert a space before "cycloalkylene" of l. 3.

Claim 12 currently depends from itself, it should apparently depend from claim 2.

Claim 14 currently depends from claim 13 which appears to be an error; it apparently should depend from claim 12. Claim 17 has the same problem.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-7, 10-18, 21, 23-25 and 27-37 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hidalgo Llinas as cited in and for the reasons of record given in the previous Office action.

8. Claims 1-7, 10-18, 21, 23-25 and 27-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antberg in view of Welborn as cited in and for the reasons of record given in the previous Office action.

9. Claims 1-7, 10-18, 21, 23-25 and 27-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Canich et al., WO 92/05203 (hereafter referred to as Canich) (this reference is the WIPO equivalent of USP 5,057,475).

Canich discloses the invention substantially as claimed (examples).

Canich does not teach or disclose the use of the metallocenes of the present invention as being necessary to make the presently claimed composition.

However, the present claims are couched in product by process language, and the disclosed process of Canich appears as if it would result in the same actual composition as the present claims.

Since the prior art appears to describe and teach the invention as claimed on the basis of inherent property characteristics which either anticipate or render obvious the present claims, an

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alternative 102/103 rejection is deemed appropriate, and the burden of proof that it does or does not shift to applicants as in *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Pasterczyk

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4/19/04